

REMARKS

Claims 1-29 are pending in this application. Claims 1, 26, and 29 are independent claims. Claims 1-29 stand rejected in the pending final office action, rejections that were maintained in the advisory action mailed December 20, 2007. Claim 24 has been canceled herein without prejudice to the assignee's right to pursue the subject matter of the claim in the future. Claim 30 has been added herein. The assignee traverses the rejections of the pending claims.

Claim Rejections - 35 U.S.C. § 103

Claims 1-2, 5-23, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0115448, application of Bouchard (Bouchard) in view of U.S. Patent Application No. 2002/0199119, application of Dunnion, et al. (Dunnion). Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouchard in view of Dunnion and further in view of U.S. Patent No. 6,795,924, issued to Kiessling, et al. (Kiessling). Finally, claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunnion in view of U.S. Patent No. 6,397,261, issued to Eldridge, et al. (Eldridge). These rejections are traversed.

Claim 1 is directed to a method for handling secure message attachments for a mobile device wherein a secure message is processed at a server in order to locate a second attachment within the secure message.

The advisory action rejected claim 1 by stating the following with respect to the Dunnion reference:

“The argument features that there is no mechanism to permit a user to request that an attachment be provided separately from the message within

which the second attachment was located. The examiner respectfully disagrees with the applicant's statement and asserts that Dunnion et al. discloses that the user requests that the message attachments be saved, in turn the mail applet request for the contents of each attachment one at a time (paragraph 124, lines 7-9); this applies to a secure message because secure messages include attachments (paragraph 137)."

The assignee respectfully disagrees with the characterization of Dunnion in the advisory action. For example, the advisory action states that the mail applet's requesting of message attachments one at a time in paragraph 124 of Dunnion "applies to a secure message because secure messages include attachments (paragraph 137)." However, the first sentence of paragraph 124 of Dunnion specifically shows that the subject matter of paragraph 124 involves only "normal (non-secure) email." Paragraph 124 of Dunnion goes on to discuss a "Request Message Contents" function. The description of the "Request Message Contents" function in Table 4 of Dunnion reads:

"Get message contents from mail-server. Convert form [sic] MIME format into proprietary format for efficient transmission. If message is secure send complete message, else send message without attachment binary data." (Emphasis added.)

As this passage explicitly states, the approach taught in Dunnion with respect to non-secure messages is inapplicable to secure messages, as the secure message approach taught by Dunnion sends the complete message, including attachments, in response to a "Request Message Contents" message. This teaching contradicts the statement in the advisory action that the non-secure message approach in Dunnion "applies to a secure message because secure messages include attachments." For at least this reason, claim 1 is patentable over the cited references and should proceed to issuance.

The advisory action responds similarly to the argument that the cited references do not disclose that the server provides the second attachment in response to a request from the mobile device. As discussed above, the advisory action cites paragraph 124, stating again that the

paragraph discloses the mail applet's requesting the attachments one at a time. As discussed above, Dunnion limits the scope of this teaching to non-secure messages, yet the advisory action states again that the approach taught in paragraph 124 applies to secure messages, citing paragraph 137. For the same reasons discussed above, Dunnion explicitly contradicts the statement in the advisory action. For this additional reason, claim 1 is patentable over the cited references, and it should proceed to issuance.

With respect to claim 26, the advisory action again cites paragraphs 124 and 137 of Dunnion. The advisory action states:

The argument features that neither a second attachment within a secure message is received by a server as a first attachment nor a secure message processing module that searches for such a second attachment. The examiner respectfully disagrees with the applicant's statement and asserts that Dunnion et al. discloses that the mail servlet (server) has a message(s) and its content and provides the contents/attachments one at a time when requested to (paragraph 124, lines 1-12; paragraph 137).

As discussed above in response to the rejections of claim 1, the cited portions of Dunnion do not teach that the attachment of a secure message is provided by the server at a different time than the secure message; rather, they teach the exact opposite – that the entire message, including any attachments, is provided all at once. In addition, nothing in the passages cited from Dunnion discloses a secure message processing module that looks into the secure message through the secure layer in order to locate the second attachment, as required by claim 26. For at least these reasons, claim 26 is patentable over the cited references and should proceed to issuance.

The assignee also disagrees with other positions taken in the final office action, which were not addressed in the advisory action. For example, claim 13 recites that the secure message without the second attachment is sent from the server to the mobile device and the second attachment is provided to the mobile device based upon a request from the mobile device. In rejecting this claim, the office action cites paragraph 54, lines 9-12 and paragraph 56, lines 1-14

of Bouchard as disclosing the claimed subject matter. The cited passages from Bouchard read as follows:

If, however, the corporate e-mail server 216 finds a matching address in the recipient address table 324, the corporate e-mail server 216 then searches for a rule associated with the recipient address in a rules table 328

...

Referring to FIG. 5 and FIG. 6, the master e-mail server 224 then processes the message 304. The processing includes placing the first e-mail body 308 into another, second attachment or file 504 (STEP 604). The second file 504 may be a graphical file, textual file, e-mail, sound file, or any other file that can be transmitted across the network 112. The master e-mail server 224 then attaches the second file 504 to a second e-mail 508 (STEP 608). In one embodiment, the master e-mail server 224 generates a second e-mail body 512 for the second e-mail 508, such as text stating that the second e-mail 508 is delivered from the master e-mail server 224. Further, the second e-mail 508 also includes the first attachment 312 that the user wants to send to the recipient address 316.

These passages teach the steps a user would take to send an e-mail according to the procedure in Bouchard. Claim 13 recites that the secure message without the second attachment is sent from the server to the mobile device. Nothing in the cited passages discloses the claimed subject matter. The passages from Bouchard describe a typical e-mail system, where the message is “pushed” to the recipient all at once. Such a system does not disclose independently sending the original message within which the second attachment was located and providing the second attachment based upon the mobile device requesting the second attachment, as recited in claim 13. For at least these reasons, the cited references fail to render claim 13 obvious. Claim 13 thus is allowable and should proceed to issuance.

Claim 14 recites that a user of the mobile device requests that the second attachment be provided to the mobile device. As discussed above, the second attachment (which is provided based upon a request from the mobile device) is sent at a different time than the secure message. This aspect makes it possible to avoid unnecessarily downloading the data representing the

second attachment and incurring the associated charges and delays. In rejecting claim 14, the office action cites paragraph 54, lines 9-12 and paragraph 56, lines 1-14 of Bouchard as disclosing the claimed subject matter.

As discussed above, these passages describe the steps taken by a user to send an e-mail according to the procedure disclosed in Bouchard. Claim 14 is directed to a request by a user (e.g., the e-mail recipient) to have the second attachment provided to the user's mobile device. In addition, as shown above, Bouchard teaches a procedure for providing message attachments that is transparent to the user. (See Abstract.) In other words, there is no mechanism in Bouchard to permit a user to request that an attachment be provided separately from the message within which the second attachment was located. In at least this way, Bouchard teaches away from the subject matter of the instant application. As the Supreme Court stated in the recent *KSR* case, "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (citing *U.S. v. Adams*, 383 U.S. 39, 51-52 (1966)). Thus, for at least these reasons, the cited references fail to render obvious the subject matter of claim 14. Claim 14 therefore should proceed to issuance.

Independent claim 29 recites subject matter analogous to that of claims 1 and 26. Further, the rationale in the final office action for rejecting claim 29 was the same as that stated in the rejection of claim 1. Thus, for at least the reasons set forth herein with respect to claims 1 and 26, claim 29 also is allowable and should proceed to issuance.

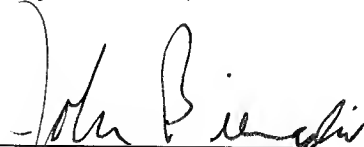
Because independent claims 1, 26 and 29 are allowable, their respective dependent claims also are allowable and should proceed to issuance. It is noted that the assignee has not, at this time, presented arguments with respect to certain dependent claims in the instant application.

The assignee nevertheless reserves the right to argue the patentability of all of the dependent claims in the instant application at a future time, should that become necessary.

CONCLUSION

For the foregoing reasons, assignee respectfully submits that the pending claims are allowable. Therefore, the examiner is respectfully requested to pass this case to issuance.

Respectfully submitted,

By: 

John V. Biernacki
Reg. No. 40,511
JONES DAY
North Point
901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-3939